

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : F. Randall Murray II
Serial No. : 10/675,121
Filed : September 30, 2003
For : APPARATUS, METHOD, AND COMPUTER PROGRAM FOR
PROVIDING INSTANT MESSAGES RELATED TO A
CONFERENCE CALL
Group No. : 2444
Examiner : Joiya M. Cloud
Confirmation No. : 4965

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated below, demonstrating the clear legal and factual deficiency of the rejections of the claims.

Claims 1-9, 11-18, 20-24 and 26-32 were rejected under 35 U.S.C. § 102(e) as being anticipated by Dalal (US Patent Application Publication No. 2003/0014488). Claims 10, 19 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dalal in view of Desai (US Patent 6,618,746). The rejections are respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

For ease of reference, independent Claim 1 is set forth below in its entirety:

1. A method for call conferencing in an Internet Protocol (IP) communications network, the method comprising:
 - controlling a conference call with a server within the IP network;
 - detecting an event associated with the conference call, the conference call associated with a plurality of participants **within the IP network;**
 - generating at the server one or more instant message associated with the detected event, the one or more instant messages having Session Initiation Protocol (SIP) format; and**
 - communicating the one or more SIP instant messages from the server to one or more of the participants.** (emphasis added).

The final Office Action argues Dalal's service provider conference controller (SPCC) – as shown and described in Figure 1 and paragraph 0022 – meets the first claimed element. And the Office Action also asserts that Dalal can detect an event, such as a telephone user hanging up during a conference call, citing to paragraph 0092.

Next, the Office Action argues that Dalal (paragraph 0092) teaches “communicating one or more instant messages associated with the detected event from the server to one or more of the participants by communicating the instant message to a network device external to the server.” Office Action, page 3. More particularly, the Office points to a NOTIFY-HANG-UP request as

equivalent to the recited instant message. However, the Office Action does not address the following claim language and fails to point to any portion of Dalal to support a finding of anticipation:

1. generating at the server one or more instant messages;
2. the one or more instant messages having Session Initiation Protocol (SIP) format;
3. communicating the one or more SIP instant messages from the server to one or more of the plurality of participants.

To show the deficiencies in the 102 rejection, Applicant sets forth below in its entirety paragraph 0092 for which the Office relies as teaching each of the three above-identified claim elements:

[0092] When the telephone user hangs up the phone, the VoIP-PSTN GATEWAY alerts the SM of the PSTN PROXY, which in turn releases resources used by the MIXER and ROUTER and then sends a NOTIFY-HANG-UP request to the SPMS. This request may include, but is not limited to, the CID of the conference and the telephone number. Upon receiving this request, the SPMS updates its conference database record and sends back a NOTIFY-HANG-UP-OK response to the SM of the SPMS. In addition, the SPMS may relay the NOTIFY-HANG-UP request to the SPCC, which in turn, alerts the conference participants of the membership change as described earlier in this patent.

When the user hangs up, the VoIP-PSTN GATEWAY generates and sends a message to the PSTN PROXY, which in turn, generates and sends a NOTIFY-HANG-UP-OK request message to the SPMS, which in turn, may forward the NOTIFY request message generated by the PSTN PROXY to the SPCC (the server), which in turn, alerts the conference participants of the membership change “as described earlier in the patent.” Dalal, paragraph 0092.

Nowhere in the cited paragraph 0092 is there any disclosure that the SPCC “generates” an instant message – as the SPCC is described as being limited to only receiving and “forwarding” the NOTIFY request message generated by the SPMS (not identified as the server by the Office

Action).

Nowhere in cited paragraph 0092 is there any disclosure or description of how the SPCC “alerts” the conference participants of the hang-up event. Dalal merely states that the conference participants are “alerted” – with no further description in the paragraph to describe how they are alerted, and by what means, or what type of alert. Clearly, the cited portion of Dalal does not disclose or describe “instant messages” as that term is described and utilized in the Applicant’s specification. In addition, nowhere in cited paragraph 0092 is there any description or teaching that the “alert” – whatever that may be – is in a SIP format.¹

Notwithstanding the Office Action’s sole reliance on paragraph 0092 of Dalal, the Applicant points out that this description of the generic “alert” in paragraph 0092 does also refer to “as described earlier in this patent.” It is Applicant’s understanding that this refers to Dalal’s description of a participant leaving the conference call – paragraphs 0068-0069. As described in Dalal’s paragraph 0068, when a participant sends a LEAVE request, the “SPCC also notifies the current conference participants of the membership change by sending NOTIFY-CONF-MESSAGES . . . “ Similar to paragraph 0092, this description lacks any teaching or disclosure that the SPCC generates an “instant message” and fails to provide any disclosure or description of how the SPCC sends NOTIFY-CONF-MESSAGE or its message format. Clearly, this additional portion of Dalal does not disclose or describe “instant messages” as that term is described and utilized in the Applicant’s specification. In addition, nowhere in cited

¹ While Dalal does refer to SIP INVITE request messages, these are in reference to setting up the conference call upon receipt of a CALL request. Dalal, paragraph 0089.

paragraph 0068 is there any description or teaching that the NOTIFY-CONF-MESSAGE is in a SIP format.

The Office Action utilizes the same rationale for rejecting the other independent Claims 11 and 20, and therefore, Applicant respectfully submits that these claims are not anticipated by Dalal.

Accordingly, the Applicant respectfully requests the withdrawal of the outstanding 102 and 103 rejections of the pending claims 1-32 based on Dalal.

For at least these reasons set forth above, the Applicant asserts that the claims in the application are in condition for allowance and that the rejections of the claims are both factually and legally deficient. The Applicants respectfully request this case be returned to the Examiner for allowance or, alternatively, further examination.

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Nortel Networks Deposit Account No. 14-1315.

Respectfully submitted,

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